



UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

Paper No.

PERKINS COIE LLP
P.O. BOX 2168
MENLO PARK, CA 94026

COPY MAILED

APR 19 2005

OFFICE OF PETITIONS

In re Application of :
Alexandre Baptiste :
Application No. 10/789,451 : DECISION ACCORDING STATUS
Filed: February 26, 2004 : UNDER 37 C.F.R. § 1.47(b)
Attorney Docket No. 37469-8041.US01 :
Title: VACUUM PACKAGING APPLIANCE :
WITH REMOVABLE TROUGH :
:

This is in response to the "Petition by Person Having Proprietary Interest to File Application on Behalf of Inventor Alexandre Baptiste Who Refuses to Sign" filed November 22, 2004.

The petition is **DISMISSED**.

Rule 47 applicant is given TWO MONTHS from the mailing date of this decision to reply, correcting the below-noted deficiencies. Any reply should be entitled "Request for Reconsideration of Petition Under 37 CFR §1.47(b)," and should only address the deficiencies noted below, except that the reply may include an oath or declaration executed by the non-signing inventor. **Failure to respond will result in abandonment of the application.** Any extensions of time will be governed by 37 CFR §1.136(a).

The above-identified application was filed on February 26, 2004, naming Alexandre Baptiste as sole inventor, but without an executed oath or declaration; missing the statutory basic filing fee; with additional claim fees due; and requiring replacement drawings. Accordingly, on May 19, 2004, the Office mailed a Notice to File Missing Parts of Application requiring those items, as well as, the late oath or declaration surcharge. The petition set a two-month period for reply with extensions of time obtainable under § 1.136(a).

On November 22, 2004 (certificate of mailing November 19, 2004), applicants responded with a check in the amount of \$2,990 (for petition fee, statutory basic filing fee, additional claim fees, late surcharge and extension of time within the fourth month); the instant petition and declaration executed by the assignee. Rule 47 applicant petitions for assignee Tilia International, Inc., to file the above-identified application on behalf of inventor Baptiste. Applicant asserts that such status under 37 CFR § 1.47(b) is proper because sole inventor Baptiste has refused to join in the application.

A grantable petition under 37 CFR § 1.47(b) requires: (1) an acceptable oath or declaration in compliance with 37 CFR §§ 1.63 and 1.64 or 1.175; (2) that the rule 47 applicant state his or her relationship to the inventor as required by 37 CFR § 1.64; (3) proof that the non-signing inventor cannot be found or reached after diligent effort, or refuses to sign the oath or declaration after having been presented with the application papers (specification, claims and drawings); (4) the petition fee; (5) a statement of the last known address of the non-signing inventor; (6) that rule 47 applicant make out a *prima facie* case (i) that the invention has been assigned to him or her or (ii) that the inventor has agreed in writing to assign the invention to him or her or (iii) otherwise demonstrate a proprietary interest in the subject matter of the invention; and (7) that rule 47 applicant prove that the filing of the application is necessary (i) to preserve the rights of the parties or (ii) to prevent irreparable damage. See MPEP §409.03(g). See 35 U.S.C. §118; 37 CFR 1.47; §§ 409.03 and 605 of the *Manual of Patent Examining Procedure*, Eighth Edition, Revision 2, (May 2004) (MPEP).

Petitioner submits statements of fact of Judy Lagero Vo and Brian R. Coleman to show the unavailability of inventor Baptiste to join in the application. The declaration filed November 22, 2004, has been reviewed and found in compliance with § 1.63. Moreover, the petition submitted includes the petition fee and the last known address of inventor Baptiste. Petitioner has submitted an employment agreement to show that inventor Baptiste agreed to assign with a declaration that the invention was made by inventor Baptiste while employed by the 37 CFR 1.47(b) applicant. Petitioner declares that acceptance of the declaration and according of a filing date is necessary to preserve the rights of, and to prevent irreparable damage to, the assignee/petitioner.

However, the statements of fact, and other evidence of record, are not sufficient to show refusal. See MPEP 409.03(d). The petition includes an account of inventor Baptiste making an oral refusal to join in the application. However, before a refusal can be alleged, rule 47 applicant must demonstrate that a *bona fide* attempt was made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the non-signing inventor. See MPEP 409.03(d). The declaration and supporting documentation only support a conclusion that the declaration and assignment were presented to inventor Baptiste. A refusal by an inventor to sign an oath or declaration when the inventor has not been presented with the application papers does not itself suggest that the inventor is refusing to join the application unless it is clear that the inventor understands exactly what he or she is being asked to sign and refuses to accept the application papers. It is reasonable to require that the inventor be presented with the application papers before a petition under 37 CFR 1.47 is granted since such a procedure ensures that the inventor is apprised of the application to which the oath or declaration is directed. *In re Gray*, 115 USPQ 80 (Comm'r Pat. 1956).

Thus, on renewed petition, rule 47(b) applicant must establish that the entire application package, including specification,

claims and drawings, was presented to non-signing inventor Martin and he subsequently refused to sign. If they have not already been sent, a copy of the application papers should be sent to the last known address of the non-signing inventor, or, if the inventor is represented by counsel, to the address of the non-signing inventor's attorney. Documentary evidence, including copies of the transmittal cover letters and return mail receipts, should be made part of the record.

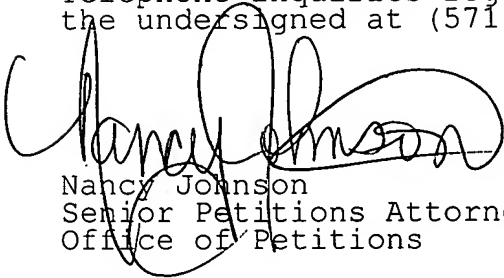
Further correspondence with respect to this decision should be addressed as follows:

By mail: Mail Stop Petition
 Commissioner for Patents
 P.O. Box 1450
 Alexandria, VA 22313-1450

By fax: (703) 872-9306
 ATTN: Office of Petitions

By hand: Customer Service Window
 Randolph Building
 401 Dulany Street
 Alexandria, VA 22314

Telephone inquiries regarding this decision should be directed to the undersigned at (571) 272-3219.



Nancy Johnson
Senior Petitions Attorney
Office of Petitions